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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/864,691

05/23/2001

Hsin-Wang Wayne Chang

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2086

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03/22/2006

Mr. C. P. Chang
Pacific Law Group LLP
224 AIRPORT PARKWAY
SUITE 525
San Jose, CA 95110

EXAMINER

COFFY, EMMANUEL

ART UNIT

PAPER NUMBER

2157

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/864,691

Applicant(s)

CHANG, HSIN-WANG WAYNE

Examiner

Emmanuel Coffy

Art Unit

2157

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on January 13, 2006 has been entered.

Claims 1-27 are pending. Claims 1-27 are pending. Claims 1-27 are directed to a system for a "Distributed Computer Resource bartering System."

Response to Arguments

2. Applicant's arguments revolve around the following central issue:

Applicant asserts that "As supported in paragraphs (027) and (030), the coordination computing device is executing a negotiation process that requires human intervention to determine importance and valuation of a task to subsequently reach a bartering contract with some of the computing devices". See remarks, page 8, 3rd full paragraph. The same argument is repeated regarding claims 14 and 15. See remarks, page 9, 2nd full paragraph.

Although the argument is persuasive, however, the amendment raises the following issues:

- a) The first is § 101 concreteness issue; and
- b) A corollary §112, 1st enablement issue.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1 and 14-15 are rejected under 35 U.S.C. 101 due to lack of concreteness in operation because of the human involvement as recited in said claims. The outcome could vary due to human involvement, incapable of producing assured, repeatable results. To avoid such results, the human intervention has to be based on objective criteria. The added element recites: "...executing a negotiation process requiring human intervention to determine importance and valuation of a task and benefits to subsequently reach a bartering contract with some of the computing devices..." As written, the basis for determination is the human intervention. Nowhere in the spec that the Examiner can ascertain are there any objective criteria upon which this determination is made. If however, Applicant believes otherwise to please indicate where those objective criteria are to be found in the spec. Human intervention is only mentioned in paragraph 052 of the original spec and it states: "Automatic negotiation algorithm or negotiation algorithm with human intervention are implemented in the bartering engine for the relevant valuation parameters to reach a bartering contract."

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1 and 14-15 are rejected under 35 U.S.C. 112, first paragraph. Specifically, due to the added limitation "...executing a negotiation process requiring human intervention to determine importance and valuation of a task and benefits to subsequently reach a bartering contract with some of the computing devices..." the invention is incapable of producing assured, repeatable results and lacks concreteness for the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. Therefore, the disclosure is not enabled. An analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the art to make and use the claimed invention. See MPEP 2164.01.

The disclosure is not enabled because the added limitation renders the claim overly broad. As stated above, the basis for determination is the human intervention. Nowhere in the spec that the Examiner can ascertain are there any objective criteria upon which this determination is made. Since there are no working examples, and no direction was provided, the quantity of experimentation required would be overwhelming. The subject matter being bartering or contract is inherently subjective, hence introducing some unpredictability into the claimed invention. Therefore, the outcome would vary according to the specific individual making the determination. The dependent claims failed to further limit the claimed subject matter and are therefore, rejected based upon their dependency upon claims 1 and 15.

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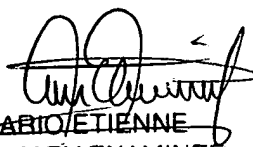
CONCLUSION

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emmanuel Coffy whose telephone number is (571) 272-3997. The examiner can normally be reached on 8:30 - 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571) 272-4001. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Emmanuel Coffy
Patent Examiner
Art Unit 2157

EC
March 16, 2006


ARIO ETIENNE
PRIMARY EXAMINER